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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,576	11/09/2001	Robert J. Greenberg	S100-DIV3	8383

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EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3762

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,576

Applicant(s)

GREENBERG ET AL.

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/9/01 (Initial Filing/ Prel. Amend.).
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 269--331 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 269-331 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 269-278, 282-286 and 310-317, drawn to an implantable electrode array, classified in class 607, subclass 054.
 - II. Claims 279-281 and 293-309, drawn to an implant device, classified in class 607, subclass 054.
 - III. Claims 287-292 and 318-331, drawn to a visual prosthesis, classified in class 607, subclass 054.

In addition if Group I. is selected, this application contains claims directed to the following patentably distinct species of the claimed invention:

- A first Group I. species, claims 269-270, drawn to an implantable electrode array comprising a plurality of protuberances.
- A second Group I. species, claim 271, drawn to an implantable visual prosthesis.
- A third Group I. species, claim 272, drawn to an implantable electrode array comprising an electrode array body having a generally curved surface on at least one side.
- A fourth Group I. species, claims 273-274, drawn to an implantable electrode array comprising a plurality of electrodes exposed in more than one dimension.
- A fifth Group I. species, claims 275-278, drawn to an implantable electrode array for retinal simulation.

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- A sixth Group I. species, claim 282, drawn to an implantable electrode array for neural stimulation comprising pyrolytic carbon electrodes.
- An seventh Group I. species, claims 283-286, drawn to an eye-implantable retinal electrode array.
- A eighth Group I. species, claims 310-315, drawn to an implantable electrode array comprising a plurality of electrodes having different lengths.
- A ninth Group I. species, claims 316-317, drawn to an implantable electrode array comprising a plurality of elongated electrodes.

In addition, if Group II. is selected, this application contains claims directed to the following patentably distinct species of the claimed invention:

- A first Group II. species, claims 279-281, drawn to an implantable device comprising and integrated circuit.
- A second Group II. species, claims 293-309, drawn to an implantable device comprising a metallic pad.

In addition if Group III. is selected, this application contains claims directed to the following patentably distinct species of the claimed invention:

- A first Group III. species, claims 287-288 and 290-292, drawn to a visual prosthesis comprising a plurality of electrodes disposed on an electrode array body in at least two dimensions/ method of stimulating visual neurons.
- A second Group III. species, claim 289, drawn to and implantable electrode array for neural stimulation comprising a control unit.

- A third Group III. species, claims 318-322, drawn to a visual prosthetic comprising a video receiver.
- A fourth Group III. species, claims 323-324, drawn to a visual prosthesis comprising an external power unit.
- A fifth Group III. species claims 325-331, drawn to a visual prosthesis comprising an electronic device implanted behind the eye.

The inventions are distinct, each from the other because of the following reasons:

Inventions II. and I. are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require an electrode array body with a plurality of protuberances (inventions I.)/ with electrodes recessed in the voids (invention II.)/ with the array body having a generally curved surface (invention III.)/ with a plurality of electrodes exposed in more than one dimension, read as three dimensions (invention IV.)/ with a plurality of electrodes deposited on the electrode array body (invention V.)/ with a plurality of pyrolytic carbon electrodes (invention VI.)/ with an epiretinal electrode and a subretinal electrode (invention VII.)/ with a plurality of electrodes having different lengths (invention VIII.)/ with insulation deposited on portions of the plurality of elongated electrodes (invention IX.). As to the first

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Group II. species, the subcombination has separate utility such as an implantable electrode array not requiring an integrated circuit, but rather using a metallic pad on the implantable device body to create the circuit. As to the second Group II. species, the subcombination has separate utility such as an implantable electrode array not requiring a metallic pad on the implantable device body, but rather using an integrated circuit to create the circuit.

Inventions III. and I. are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require an electrode array body with a plurality of protuberances (inventions I.) / with electrodes recessed in the voids (invention II.) / with the array body having a generally curved surface (invention III.) / with a plurality of electrodes exposed in more than one dimension, read as three dimensions (invention IV.) / with a plurality of electrodes deposited on the electrode array body (invention V.) / with a plurality of pyrolytic carbon electrodes (invention VI.) / with an epiretinal electrode and a subretinal electrode (invention VII.) / with a plurality of electrodes having different lengths (invention VIII.) / with insulation deposited on portions of the plurality of elongated electrodes (invention IX.). As to the first, second, third and fifth Group III. species, the subcombination has separate utility such as an implantable electrode array not requiring a control unit (implanted) / internal communication unit to activate/ drive the electrodes, but rather using an external control unit to activate/ drive the

electrodes. As to the fourth Group III. species, the subcombination has separate utility such as an implantable electrode array not requiring an external unit to provide power to the array through an internal power unit, but rather providing an implantable power source, such as by a non-rechargeable implanted battery, to power the array.

Inventions III. and II. are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require capacitors (invention I.) / a metallic pad (invention II.). As to the first, second, third and fifth Group III. species, the subcombination has separate utility such as an implantable device not requiring a control unit (implanted) / internal communication unit to activate/ drive the electrodes, but rather using an external control unit to activate/ drive the electrodes. As to the fourth Group III. species, the subcombination has separate utility such as an implantable device not requiring an external unit to provide power to the array through an internal power unit, but rather providing an implantable power source, such as by a non-rechargeable implanted battery, to power the array.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are not claims that are deemed to be generic.

The Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, the Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should the applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more

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of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza whose telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4520 for regular communication and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

10/9/00



ANGELA D. SYKES
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